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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,685	11/21/2003	William R. Murray JR.	20006-7005	1898

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EXAMINER	
NGUYEN, DUSTIN	

ART UNIT	PAPER NUMBER
2154	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/719,685	Applicant(s) MURRAY ET AL.	
	Examiner Dustin Nguyen	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1 – 29 are presented for examination.

Drawings

2. The drawings are objected to because no label for Figure 2 as disclosed in the specification, paragraphs 0035-0039. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-16 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It appears claim 1 would reasonably be interpreted by one of ordinary skill as a system of software per se, failing to fall within a statutory category of invention. Applicants' disclosure contains no explicit and deliberate definition for the term "subsystem", and in the context of the disclosure and claims in question, one of ordinary skill would reasonably interpret the subsystems as software applications. As such, the system of subsystems alone is not a machine, and it is clearly not a process, manufacture nor composition of matter.

Claims 21-23 and 27-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As per claims 21 and 27, the specification contains intrinsic evidence that "computer readable medium" includes electromagnetic, infrared and propagated. As such, they are directed to non-statutory subject matter [see Interim Guideline for Patent Subject Matter Eligibility, MPEP, section 2106].

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6, 8-10, 17, 20, 21 and 24-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Cocotis et al. [US Patent Application No 2003/0078965].

6. As per claim 1, Cocotis discloses the invention as claimed including a system [i.e. system for managing such as printing over various types of computer networks] [Abstract, paragraphs 0002 and 0005] comprising:

a network search subsystem for responding to a query to present a compilation of a set of a plurality of remote network resources [i.e. query for a list of available public devices] [Figure 2; Abstract; paragraphs 0005, 0201 and 0205], each remote network resource of said set having an identifier [i.e. URL] [paragraphs 0213, 0214 and 0300]; and

a remote processing initiation subsystem for associating an actuable control with one or more of said remote network resources of said set [i.e. remote printing of URL] [paragraphs 0304, 0308 and 0323], each said actuable control initiating a processing of said associated remote network resource at a remote processor responsive to communication of an initiation signal including said identifier [i.e. send data to device and printing completion notice] [Figures 16 and 18; and paragraphs 0204-0206].

7. As per claim 2, Cocotis discloses wherein said remote processor includes an image production system [i.e. render output image data] [Figure 53; Abstract; and paragraph 0005].

8. As per claim 3, Cocotis discloses wherein said image production system includes a printer [Abstract; paragraphs 0003 and 0004].
9. As per claim 4, Cocotis discloses wherein said initiation signal includes a metadata parameter of said associated remote network resource [paragraphs 0226 and 0210].
10. As per claim 6, Cocotis discloses wherein said metadata parameter is identified when said associated remote network resource is indexed for said network search subsystem [paragraphs 0154, 0280, 0344 and 0345].
11. As per claim 8, Cocotis discloses wherein said metadata parameter is identified by a process coupled to a compilation presentation system [paragraphs 0004 and 0246].
12. As per claim 9, Cocotis discloses wherein said associated remote network resource is a document in portable document format (PDF) and said process includes a PDF access process [paragraphs 0305 and 0323].
13. As per claim 10, Cocotis discloses a configurator process for configuring one or more processing options for said processing of said remote network resource [paragraphs 0323 and 0358].

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14. As per claim 17, it is rejected for similar reasons as stated above in claims 1, 4 and 6.
15. As per claims 20 and 21, they are rejected for similar reasons as stated above in claims 1, 4 and 6.
16. As per claim 24, it is rejected for similar reasons as stated above in claim 1.
17. As per claim 25, it is rejected for similar reasons as stated above in claim 4.
18. As per claim 26, it is rejected for similar reasons as stated above in claim 9. Furthermore, Cocotis discloses one or more metadata parameters includes a page count [paragraph 0346].
19. As per claim 27, it is rejected for similar reasons as stated above in claim 1.
20. As per claims 28 and 29, they are rejected for similar reasons as stated above in claims 4 and 26.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 5, 7, 11-16, 18, 19, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cocotis et al. [US Patent Application No 2003/0078965], in view of Blumberg et al. [US Patent Application No 2003/0140315].

23. As per claim 5, Cocotis does not specifically disclose wherein said metadata parameter includes a page length of said associated remote network resource. Blumberg discloses wherein said metadata parameter includes a page length of said associated remote network resource [i.e. selecting type of paper] [paragraphs 0028 and 0068]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Cocotis and Blumberg because the teaching of selecting paper type of Blumberg would allow user to try out multiple types, personalizing them and altering them on-line without the need for the printing company to run off physical samples in multiple styles [Blumberg, paragraph 0104].

24. As per claim 7, it is rejected for similar reasons as stated above in claim 5.

25. As per claim 11, Cocotis does not specifically disclose wherein said configurator process estimates a processing cost for said processing of said remote network resource using said one or more processing options. Blumberg discloses wherein said configurator process estimates a processing cost for said processing of said remote network resource using said one or more processing options [i.e. cost determination] [paragraphs 0048, 0073 and 0074]. It would have been obvious to a person skill in the art at the time the invention was made to combine the

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teaching of Cocotis and Blumberg because the teaching of cost determination of Blumberg would allow to add convenience services for user to view finished document before making the purchase.

26. As per claim 12, it is rejected for similar reasons as stated above in claim 11.

27. As per claim 13, Cocotis discloses wherein said one or more metadata parameters includes a resource-size parameter [Table 17; and paragraphs 0363].

28. As per claim 14, it is rejected for similar reasons as stated above in claim 5. Furthermore, Cocotis discloses wherein said resource is a document [Abstract].

29. As per claim 15, Blumberg discloses wherein said processing cost is included in said compilation [paragraphs 0028 and 0068].

30. As per claim 16, Blumberg discloses wherein each said remote network resource of said set includes its processing cost proximate to its actuable control [i.e. determine pricing] [paragraphs 0124-0130].

31. As per claim 18, it is rejected for similar reasons as stated above in claim 14.

32. As per claim 19, it is rejected for similar reasons as stated above in claim 9.

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33. As per claim 22, it is rejected for similar reasons as stated above in claim 14.

34. As per claim 23, it is rejected for similar reasons as stated above in claim 9.

35. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dustin Nguyen

Examiner

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A handwritten signature in black ink, appearing to read 'Dustin', with a long, sweeping horizontal stroke extending to the right.